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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,279	12/04/2003	David Armes	03292.101730.1	7128

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EXAMINER	
CHEUNG, MARY DA ZHI WANG	
ART UNIT	PAPER NUMBER
3694	
MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/728,279	ARMES ET AL.	
	Examiner	Art Unit	
	MARY CHEUNG	3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 August 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims

1. This action is in response to the RCE filed on August 4, 2008. Claims 1-21 are pending and examined. Claims 1, 3-6, 8, 11, 14-17 and 19-21 are amended.

Response to Arguments

2. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

3. Claim 2 is objected to because of the following informalities: the claim should end with a period. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-5, 7, 10-16, 18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Adams et al., US 7,389,256 B1.

As to claim 1, Adams teaches a method for identifying payment systems for facilitating the processing of payments, comprising (abstract):

- transmitting payment criteria for purchase of an item from a customer to a supplier (column 6 lines 46-53 and column 7 lines 29-47; *"customer" corresponds to the operator 2 and "supplier" corresponds to the processing server 12 in Adams' teaching*);
- querying a directory of payment systems in an attempt to locate one or more payment systems to process the transaction based at least in part upon the payment criteria (column 6 line 59 - column 7 line 5 line 5 and column 7 lines 48-57; *"payment systems" corresponds to the account processors 6 in Adams' teaching*); and
- returning an identification of the one or more located payment systems, if any, to process the transaction, including information indicating whether the located payment systems match the payment criteria (column 6 line 59 - column 7 line 5 line 5 and column 7 lines 48-57 and Fig. 5);
- wherein the querying step is performed by the supplier (column 6 lines 46-53 and column 6 line 59 – column 7 line 5 and column 7 lines 29-47).

As to claim 2, Adams teaches interacting with the one or more located payment systems to at least partially process the transaction using the payment criteria (column 6 line 59 – column 7 line 5 and column 7 lines 48-57 and Fig. 5).

As to claim 3, Adams teaches the querying step includes selecting the one or more payment systems based upon attributes of the request for the transaction (column 6 line 59 – column 7 line 5 and column 7 lines 48-57).

As to claim 4, Adams teaches selecting the one or more payment systems based upon a customer identity (column 6 line 59 – column 7 line 5 and column 7 lines 48-57).

As to claim 5, Adams teaches authenticating an identification of the customer (column 7 lines 29-35).

As to claim 7, Adams teaches processing the transaction using a payment instrument that includes a financial component or a non-financial component (column 10 line 2 – column 11 line 15).

As to claim 10, Adams teaches identifying the one or more payment systems by corresponding routing information (column 6 line 59 – column 7 line 5 and column 7 lines 48-57).

As to claim 13, Adams teaches entering into a contract with the at least one payment system for processing the transaction (Fig. 5 and its associated text).

Claims 11-12, 14-16, 18 and 20 are rejected based on the same rationale as used for claims 1-5 and 7.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 6 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams et al., US 7,389,256 B1 in view of Rose et al., US 5,757,917.

As to claims 6 and 17, Adams does not specifically teach negotiating with the payment system a price for the item or associated fees. However, Rose discloses a computerized payment system for purchasing goods and services online where the buyer and seller may user the payment system to negotiate a price for a good or service (column 7 lines 48-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Adams' teaching to include the negotiation feature as taught by Rose so that the buyers may receive deal and the sellers may increase sales.

8. Claims 8, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams et al., US 7,389,256 B1 in view of Williams et al., US 5,815,657.

As to claims 8 and 19, Adams does not specifically teach permitting the customer to decline at least one of the one or more payment systems. Williams teaches permitting the customer to decline at least one of the one or more payment systems (column 31 lines 18-20 and Figs. 11, 13). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Adams' teaching to include the feature of permitting the customer declining at least one or more payment systems as taught by Williams so the customer can have chance to make the last minute decision for the transaction.

As to claim 21, Adams does not specifically teach the one or more payment systems based upon preferences of the customer. However, Williams teaches this matter (column 17 lines 52-54). It would have been obvious to one of ordinary skill in

the art at the time the invention was made to allow Adams' teaching to include this feature for better tailor to the customer's payment needs.

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams et al., US 7,389,256 B1 in view of Campbell et al., US 2002/0023033 A1.

As to claim 9, Adams does not specifically teach identifying, along with the one or more located payments, a rating indicating how closely the one or more payment systems match the payment criteria. However, Campbell teaches ranking the matched criteria (see ¶ 115 and claim 5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the payment criteria to be ranked so that the user can have better view of the matched result.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 10/611,034. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both disclose querying a direct of payment systems to locate at least one payment system to process transactions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (571)-272-6705. The examiner can normally be reached on Monday – Thursday from 10:00 AM to

7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (571) 272-6712.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax phone numbers for the organization where this application or proceedings is assigned are as follows:

(571) 273-8300 (Official Communications; including After Final Communications labeled “BOX AF”)

(571) 273-6705 (Draft Communications)

/Mary Cheung/
Primary Examiner, Art Unit 3694
September 19, 2008